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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,131	06/02/2000	Marc Delcourt	1184-00	6329

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EXAMINER	
TRAN, MY CHAU T	

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/586,131	DELCOURT, MARC	
	Examiner	Art Unit	
	My-Chau T. Tran	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-20 and 23* is/are pending in the application.

4a) Of the above claim(s) *20 and 23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 12-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Note: The examiner for your application in the PTO has changed. However, the Group and/or Art Unit location of your application in the PTO is remained the same, which is Group Art Unit 1639.

Status of Claims

1. Applicant's amendment filed on 10/20/2003 is acknowledged and entered. Claims 1 and 16 are amended by the amendment. Claim 23 is added by the amendment.

2. Claims 11, and 21-22 are canceled by the amendment filed on 11/25/2002.

3. Claim 20 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4/12/2001.

4. Claims 1-10, 12-19, and 23 are pending.

Election/Restrictions

5. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The elected invention (Claims 1-10, and 12-19) is directed to the method for isolating an intact clone of one target nucleic acid fragment having a known characteristic, from a number of fragments capable of containing the

target nucleic acid fragment. The newly submitted claim 23 is directed to a method for efficiently constituting expression libraries and isolating a target gene of interest. These methods are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different methods as claimed have different method steps that have different functions and modes of operation. The method step of identifying a cDNA of a tissue of interest or cell line of interest with a target activity or phenotype is not required by the claims of the elected invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

6. The previous Office Action, mailed 4/21/03, has acknowledgment applicant's claim for foreign priority based on PCT/FR98/02629 and an application filed in France on 12 April 1997 and noted that applicant ***has not filed*** a certified copies of the PCT or the French application as required by 35 U.S.C. 119(b). Since no certified copies of the PCT or the French application as required by 35 U.S.C. 119(b) has been filed, applicant's claim for foreign priority is ***denied until*** the certified copies of the PCT or the French application is submitted.

7. Claims 1-10, and 12-19 are treated on the merit in this Office Action.

Withdrawn Rejections

8. The previous rejections under 35 USC 101, for claims 1-10, and 12-19 have been withdrawn in view of applicant's amendments of claims 1 and 16, and arguments.

9. The previous rejections under 35 USC 112, first paragraph, for claims 1-10, and 12-19 have been withdrawn in view of applicant's amendments of claims 1, and 16 and argument.

10. The previous rejections under 35 USC 112, first paragraph (written description), for claims 1-10, and 12-19 have been withdrawn in view of applicant's amendments of claims 1, and 16 and argument.

11. The previous rejections under 35 USC 112, first paragraph (enablement), for claims 1-10, and 12-19 have been withdrawn in view of applicant's amendments of claims 1, and 16 and argument.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-10, and 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 briefly recites a method for isolating an intact clone of one target nucleic acid fragment having a known characteristic, from a number of fragments capable of containing the target nucleic acid fragment wherein the steps comprise of preparing a library of clones from a number of fragments, subjecting the library of clones to a plurality of restriction enzymes, and then isolating the library of clones an intact clone.

a. The term "intact clone" of claims 1, 16, and 18 is a relative term, which renders the claim indefinite. The term "intact clone" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

b. The term "intact target fragment" of claim 1 is a relative term, which renders the claim indefinite. The term "intact clone" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

c. In step (a) and step (b) of Claims 1 and 16, step (a) is 'identifying a target nucleic acid fragment having a known characteristics' and step (b) is 'providing a number of nucleic acid fragments'. It is unclear whether the "fragment" of step (b) refers to the "target nucleic acid fragment" of step (a) or the "further cleaved" fragments of "target nucleic acid fragment" in step (a).

d. In step (d) of claim 1, the method step briefly recites the production a group of "monodigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes use 'do not include those to which said vector is sensitive'. Thus, it

unclear how "monodigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the vector.

e. In step (e) of claim 1, the method step briefly recites the screening of the group of "monodigested libraries" that was produced in step (d) 'to determine those restriction enzymes to which said target fragment is insensitive'. It is unclear what the correlation between steps (e) and (d) since the restriction enzymes that are insensitive to the target fragment is determined in step (d). That is the restriction enzymes used in step (d) are insensitive to the target fragment.

f. In step (f) of claim 1, the method step briefly recites the production a "multidigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes are 'target fragment insensitive'. Thus, it unclear how "multidigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the target fragment.

g. In step (c) of claim 1, the method step briefly recites the preparation of 'an initial library of clones". It is unclear whether the same "initial library" is use for both step (d) and (f). That is only a portion of the library produce is step (c) is being use in step (d) or is the library use in step (f) a reproduction of the library use in step (d).

h. In step (e) of claim 16, the method step briefly recites the production a group of "monodigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes use 'do not include those to which said vector is sensitive'. Thus, it unclear how "monodigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the vector.

i. In step (g) of claim 16, the method step briefly recites the screening of the group of "monodigested libraries" that was produced in step (d) 'to determine those restriction enzymes to which said target fragment is insensitive'. It is unclear what the correlation between steps (g) and (e) since the restriction enzymes that are insensitive to the target fragment is determined in step (e). That is the restriction enzymes used in step (e) are insensitive to the target fragment.

j. In step (h) of claim 16, the method step briefly recites the production a "multidigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes are 'target fragment insensitive'. Thus, it unclear how "multidigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the target fragment.

k. In step (b) of claim 18, the method step briefly recites the production a group of "monodigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes use 'do not include those to which said vector is sensitive'. Thus, it unclear how "monodigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the vector.

l. In step (d) of claim 18, the method step briefly recites the production a "multidigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes are 'target fragment insensitive'. Thus, it unclear how "multidigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the target fragment.

m. In step (b) of claim 19, the method step briefly recites the production a group of "monodigested libraries" by subjecting the library to restriction enzymes. However, the restriction enzymes use 'do not include those to which said vector is sensitive'. Thus, it unclear how "monodigested libraries" is produced since the library would not be digested by the restriction enzymes that are insensitive to the vector.

14. Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is the isolating step for an intact clone since both claims 16 and 18 claimed a method for isolating an intact clone of one target nucleic acid fragment having known characteristic.

Conclusion

Allowable Subject Matter

15. Claims 1-10, and 12-19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00 -2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct
February 11, 2004

PADMASHRI PONNALURI
PRIMARY EXAMINER